

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated January 12, 2005 have been considered. Claims 1-41 remain pending in the Application. Reconsideration of the pending claims and allowance of the Application in view of the present response is respectfully requested.

Claims 1-5, 9-11, 33-35, and 38-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0174241 published for *Beged-Dov et al.* (hereinafter *Beged-Dov*). The Applicant respectfully traverses the rejections to Claims 1-5, 9-11, 33-35, and 38-41.

According to MPEP §2142, to establish a *prima facie* case of obviousness under 35 U.S.C. §103:

- 1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In reference to independent Claims 1, 33, 35, 40, and 41, the Applicant respectfully submits that *Beged-Dov*, even if modified pursuant to the Official Notice taken by the Examiner, does not teach or suggest all of the claim limitations. In particular, *Beged-Dov* at least fails to teach or suggest exposing a local clipboard of a computing device as a service to at least one external application over the network. In addition, *Beged-Dov* fails to teach or suggest receiving a transfer indication from the external application that a transfer of information is requested between the exposed local clipboard and the external application.

Generally, the system taught by *Beged-Dov* is directed to copying resources between source and destination Web resources via a client computer (see source and destination Web services 124, 122, resource 126, and client computer 104 in FIG. 1). *Beged-Dov* describes a local Internet Clipboard Proxy that runs on the client computer and controls a trusted Internet

Clipboard Service that runs on a server (see [0017] and Internet Clipboard Proxy 110 and Service 114 in FIG. 1). The user maneuvers to a source Web service and selects a resource for copying by intercepting a copy command at the Internet Clipboard Proxy (steps 209, 211, 213 of FIG. 2A). The user then maneuvers to the destination Web service and “pastes” the resource at the destination via a paste command intercepted by the Internet Clipboard Proxy (steps 225, 227, 229 of FIG. 2B). Thereafter, the resource is copied from the source Web service to destination Web service via the trusted Internet Clipboard Service (step 239 of FIG. 2B).

In contrast to independent Claims 1, 33, 35, 40, and 41 of the Application, *Beged-Dov* at least does not teach or suggest exposing a local clipboard of a computing device as a service to at least one external application over the network. This is because, in the system described by *Beged-Dov*, all clipboard actions are first initiated by the user via the Internet Clipboard Proxy and then sent to the Internet Clipboard Service. As the term is generally used in the computer arts, a “service” is a program (e.g., daemon) or similar function that is activated and awaits client requests. The Internet Clipboard Proxy could not be reasonably construed as a being a network “service,” because the Internet Clipboard Proxy has no means of accepting incoming network connections or requests. On the contrary, the Internet Clipboard Proxy of *Beged-Dov* acts purely as a client, because the Proxy provides user-initiated remote control of cut and paste actions that are thereafter activated at a server containing the Internet Clipboard Service. The Internet Clipboard Proxy of *Beged-Dov* merely allows copying resources between two Web servers using a client device without the client having to access the resources directly. In contrast, the Applicant’s invention involves *exposing* the local clipboard of a computing device *as a service* over the network. In the Applicant’s invention, the transfer of information from the local clipboard to the external application is initiated by receiving a transfer indication from the external application rather than from the user.

Additionally, *Beged-Dov* does not teach or suggest receiving a transfer indication from the external application, nor facilitating a transfer of information between the local clipboard and the external application in response to the transfer indication. This follows from the arguments above. Because transfers in *Beged-Dov* are initiated by the user and not an external application, the system of *Beged-Dov* does not receive indications that transfers are

requested by the external application, nor does the system of *Beged-Dov* facilitate transfers of information based on such indications. Thus *Beged-Dov*, even if modified pursuant to the Official Notice, does not teach or suggest every limitation of Claims 1, 33, 35, 40, and 41. As a result, the Office Action has failed to establish a *prima facie* case of obviousness, and the Applicant respectfully submits that independent Claims 1, 33, 35, 40, and 41 are in condition for allowance.

Dependent Claims 4-5 and 9-11 depend from independent Claim 1, dependent Claim 34 depends from independent Claim 33, and dependent Claims 38 and 39 depend from independent Claim 35. These dependent claims also stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Beged-Dov*. While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are now moot in view of the remarks made in connection with independent Claims 1, 33, and 35. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features that further distinguish these claims from the cited references. Therefore, dependent Claims 4-5, 9-11, 34, 38 and 39 are also in condition for allowance.

Claims 6-8, 12-24, 31, 32, 36, and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Beged-Dov* in view of U.S. Patent No. 6,202,100 issued to *Maltby et al.* (hereinafter *Maltby*). According to the Office Action, *Beged-Dov* discloses the invention substantially as claimed, except as to Claims 6-8, *Beged-Dov* does not disclose clipboard communications, and as to Claim 14, *Beged-Dov* does not disclose translating a native call to a clipboard API and executing the native call to access a local clipboard. The Examiner contends that *Maltby* teaches the limitations missing from *Beged-Dov*, and that it would be obvious to one of ordinary skill in the art to modify *Beged-Dov* in view of *Maltby*.

The Applicant traverses this rejection. *Beged-Dov* and *Maltby*, even if properly combined, do not teach or suggest each and every element of the rejected claims. In reference to independent Claim 12, *Beged-Dov* at least fails to teach or suggest exposing a local clipboard of a first device as a web service to a second device over a network. *Maltby* fails to remedy the deficiencies of *Beged-Dov*. *Maltby* describes a method of object linking and embedding over a computer network (col. 4, lines 33-35). In *Maltby*, a first user copies data into CLIPBOARD A

on a first computer. The copying is detected by a CLIP SEND routine, which sends a list of formats to CLIPBOARD B on another computer (col. 7, lines 38-48). As described in *Maltby*, CLIP SEND detects data being pasted into CLIPBOARD A and in response sends a list of formats “to the remote terminal B using standard messaging software.” However, neither *Maltby* or *Beged-Dov* describe the clipboard service as being exposed as a web service, because neither reference describes a clipboard that awaits web service connections or requests. Thus, the Office Action has failed to establish a *prima facie* case of obviousness because neither *Beged-Dov* nor *Maltby*, either alone or in combination, teach or suggest every limitation of Claim 12. Claim 12, therefore, is in condition for allowance.

Dependent Claims 13-24 and 31-32 depend from independent Claim 12 and also stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Beged-Dov* in view of *Maltby*. While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are now moot in view of the remarks made in connection with independent Claim 12. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features that further distinguish these claims from the cited references. Therefore, dependent Claims 13-24 are also in condition for allowance.

As to Claims 6-8, and 36-37, these claims also stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Beged-Dov* in view of *Maltby*. However, *Beged-Dov* and *Maltby*, even if properly combined, do not teach or suggest each and every element of Claims 6-8, and 36-37. Dependent Claims 6-8, and 36-37 depend from independent Claims 1 and 35, respectively, and include all of the limitations of the base claim and any intervening claims, and recite additional features that further distinguish these claims from the cited references. As described above in regards to Claims 1 and 35, *Beged-Dov* does not describe the local clipboard as being exposed as a service to at least one external application, at least because the clipboard described in *Beged-Dov* acts as a client, and is neither exposed as nor acts as a service to external applications over a network.

Maltby fails to remedy the deficiencies of *Beged-Dov* in this regard. As is generally known in the art, a service is exposed when it is made publicly available to other network entities. *Maltby* is silent on exposing the clipboard as a service accessible via the network,

only describing the clipboard services as utilizing conferencing software in order to exchange messages (col. 7, lines 25-29). *Maltby* does not teach or suggest exposing the services available by the clipboard because *Maltby* states that “CLIP SEND uses the COMMS system to send a message to terminal B to activate another routine (“CLIP RECEIVE”) before any data is made available from CLIPBOARD A. (col. 7, lines 35-36). Therefore, instead of exposing the CLIP SEND routine to other applications on the network as a service, the CLIP SEND routine described by *Maltby* directly contacts the receiving entity in response to a user action (i.e., the pasting of data into CLIPBOARD A by a user of terminal A). In this sense, the CLIP SEND routine of *Maltby* acts as a client because CLIP SEND initiates clipboard transactions with intended recipients, and thus the clipboard is not exposed as a service to applications via the network. Therefore, *Beged-Dov* and *Maltby*, even if properly combined, do not teach or suggest each and every element of independent Claims 1 and 35. Thus it follows that dependent Claims 6-8, and 36-37, which respectively include the same limitations as base Claims 1 and 35, are also in condition for allowance.

Claims 25-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Beged-Dov* in view of *Maltby* in further view of U.S. Publication No. 2004/0172584 published for *Jones et al.* (hereinafter *Jones*). According to the Office Action, *Beged-Dov* and *Maltby* disclose the invention substantially as claimed, except *Beged-Dov* and *Maltby* do not disclose marking the data at an external application. Nonetheless, according to the Office Action, *Jones* teaches marking the data at an external application, and therefore it would be obvious to one of ordinary skill in the art to modify *Beged-Dov* in view *Maltby* and in further view of *Jones*.

The Applicant traverses this rejection. *Beged-Dov*, *Maltby*, and *Jones*, even if properly combined, do not teach or suggest each and every element of the rejected claim. In particular, none of these references, alone or in combination, teach or suggest exposing a local clipboard of a computing device as a service to at least one external application over the network. As described in greater detail above, *Beged-Dov* and *Maltby* fail to describe this limitation, and *Jones* fails to remedy the deficiencies of *Beged-Dov* and *Maltby*.

Jones describes an enhanced cut and pasting functionality using XML descriptors in order to maintain structure and formatting of the pasted data. *Jones* merely describes

enhancements to existing inter-application cut and paste functionality. Jones does not describe exposing a exposing a local clipboard of a computing device as a web service, but merely states in broad terms that “program modules may be located in both local and remote memory storage devices” ([0023]). Therefore, because *Beged-Dov*, *Maltby*, and *Jones*, either alone or in combination, fail to teach or suggest exposing a exposing a local clipboard of a computing device as a web service, the Office Action has failed establish a *prima facie* case of obviousness, and the Applicant respectfully submits that Claims 25-30 are in condition for allowance.

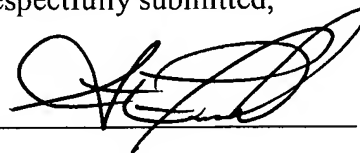
The Applicant also respectfully contends that the proper motivation to modify or combine references has not been established. Thus, while the Applicants respectfully submit that *prima facie* obviousness is not established because all claim limitations are not taught by the cited combinations, the Applicant does not acquiesce that the requisite motivation to combine references has been established or that a reasonable expectation of success exists. The Applicant reserves the right to further address these elements of a *prima facie* case of obviousness.

If the Examiner finds it helpful, the undersigned attorney of record invites the Examiner to contact him at 651-686-6633 (x110) to discuss any issues related to this case.

Respectfully submitted,

Date: March 31, 2005

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